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EXAMINER

STACE, BRENT S

ART UNIT PAPER NUMBER

2161

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/674,802

Applicant(s)

PAGE, LAWRENCE E.

Examiner

Brent S. Stace

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-50 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-50 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 September 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 20060327.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Remarks***

1. Claims 1-50 have been examined. Claims 1-50 have been rejected. This document is the first Office action on the merits.

### ***Information Disclosure Statement***

2. The information disclosure statement is being considered by the examiner.

### ***Specification***

3. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

### ***Drawings***

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "210" and "110" have both been used to designate the document title. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each

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drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

5. Since the lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors, Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the drawings. For example, the drawings should be carefully checked to ensure that all reference numerals are described in the specification, that no one reference numeral describes two separate drawing elements, or that the specification contains no reference to numerals not in the drawings.

### ***Claim Objections***

6. Claims 9, 30, and 44 are objected to because of the following informalities:
- a. Claim 9 and 30 contain a list of limitations. According to grammar, the last element in the list should be preceded by an "and" or an "or."
  - b. Claim 44 is objected to because it depends on a claim listed after it (Claim 45). It appears from the preamble and other aspects of the claim that it was intended to be dependant on Claim 43 and not Claim 45.
- Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claim 42 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

9. Claim 42 recites the limitation "another electronic version" in line 2. This is unclear since a first electronic version was never specified.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1, 13-17, 21, 22, 34-38, 47, and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,634,051 (Thomson) in view of "How to Interpret your Search Results" (Google1).

12. For **Claim 1**, Thomson teaches: "A computer-implemented method for searching in response to Internet-based search queries [Thomson, col. 3, lines 47-50 with Thomson, col. 4, lines 9-13] using a search engine [Thomson, col. 4, lines 36-41] and a searchable electronic database, [Thomson, col. 5, lines 15-20] comprising:

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- storing in the searchable database data sets representing printed items from publications respectively printed by a plurality of respective publishers, [Thomson, col. 10, lines 1-16 with Thomson, col. 8, lines 4-21] each data set including text from at least one of the printed items; [Thomson, col. 8, lines 4-21] and
- using the search engine, responding to a search query by
  - and searching the data sets in the electronic database for data sets that are relevant to the search query, thereby identifying and relevant data sets corresponding to relevant publication items, [Thomson, col. 8, lines 16-21] and
  - and at least one characterization of at least one of the relevant publication items [Thomson, col. 8, lines 47-57].

Thomson discloses the above limitations but does not expressly teach:

- "searching for web pages that are relevant for the search query
- relevant Internet web pages
- returning at least one characterization of at least one of the relevant web pages
- and, for said at least one of the relevant publication items providing an electronic path for accessing further information."

With respect to Claim 1, an analogous art, Google1, teaches:

- "searching for web pages that are relevant for the search query [Google1, page 1]

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- relevant Internet web pages [Google1, page 1]
- returning at least one characterization of at least one of the relevant web pages [Google1, page 1]
- and, for said at least one of the relevant publication items providing an electronic path for accessing further information" [Google1, page 1 with Thomson, col. 8, lines 4-10]."

It would have been obvious to one of ordinary skill in the art at the time of invention to combine Google1 with Thomson because both inventions are directed towards searching documents.

Google1's invention would have been expected to successfully work well with Thomson's invention because both inventions use the internet for searching. Thomson discloses an information management systems comprising searching for documents relevant to a query, however Thomson does not expressly disclose web pages as search results and characterizations thereof or electronic paths for access. Google1 discloses search results from Google comprising web pages as search results and characterizations thereof.

It would have been obvious to one of ordinary skill in the art at the time of invention to take the web pages as search results, characterizations thereof, and electronic paths for access from Google1 and install it into the invention of Thomson, thereby offering the obvious advantage of finding web pages associated with the documents found, accessing them and the user quickly determining the relevance of the returned result(s).

13. **Claim 13** can be mapped to Thomson (as modified by Google1) as follows: "The method of claim 1, further including creating an index of the data sets in the searchable database" [Thomson, col. 8, lines 16-21].
14. **Claim 14** can be mapped to Thomson (as modified by Google1) as follows: "The method of claim 1, further including configuring the data set to display as a replica of the corresponding printed media" [Thomson, col. 10, lines 1-16].
15. **Claim 15** can be mapped to Thomson (as modified by Google1) as follows: "The method of claim 1, further including creating an index of the data sets in the searchable database and wherein returning includes providing a hyperlink for an indexed entry with another representation of one of the printed items" [Google1, page 1 with Google1, Page 2, Q].
16. **Claim 16** can be mapped to Thomson (as modified by Google1) as follows: "The method of claim 1, wherein providing an electronic path for accessing further information includes providing at least one hyperlink that, when acted upon, links said at least one of the relevant publication items to a more complete electronic representation of the relevant publication items" [Google1, page 1 with Google1, Page 2, K, L, and O].
17. **Claim 17** can be mapped to Thomson (as modified by Google1) as follows: "The method of claim 1, wherein providing an electronic path for accessing further information includes providing at least one hyperlink that, when acted upon, links said at least one of the relevant publication items to an electronic representation of the relevant publication item, the electronic representation of the relevant publication item beginning



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as a continuation of information returned" [Google1, page 1 with Google1, Page 2, K, L, and O].

18. **Claim 21** encompasses substantially the same scope of the invention as that of Claim 1, in addition to an arrangement and some means for performing the method steps of Claim 1. Therefore, Claim 21 is rejected for the same reasons as stated above with respect to Claim 1.

19. **Claims 22 and 34-38** encompass substantially the same scope of the invention as that of Claims 1 and 13-17, respectfully, in addition to an arrangement and some elements for performing the method steps of Claims 1 and 13-17, respectfully.

Therefore, Claims 22 and 34-38 are rejected for the same reasons as stated above with respect to Claims 1 and 13-17, respectfully.

20. **Claim 47** encompasses substantially the same scope of the invention as that of Claim 1, in addition to a machine-implemented method and some steps for performing the method steps of Claim 1. Therefore, Claim 47 is rejected for the same reasons as stated above with respect to Claim 1.

21. **Claim 50** encompasses substantially the same scope of the invention as that of Claim 1, in addition to a machine-implemented method and some steps for performing the method steps of Claim 1. Therefore, Claim 0 is rejected for the same reasons as stated above with respect to Claim 1.

22. Claims 2, 3, 23, 24, 48, and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,634,051 (Thomson) in view of "How to Interpret

your Search Results" (Google1), further in view of U.S. Patent Application Publication No. 2003/0229637 (Baxter et al.).

23. For **Claim 2**, Thomson (as modified by Google1) teaches: "The method of claim 1."

Thomson (as modified by Google1) discloses the above limitation but does not expressly teach:

- "wherein the printed items, that are represented by stored data sets in the searchable database, are copyrighted printed items."

With respect to Claim 2, an analogous art, Baxter, teaches:

- "wherein the printed items, that are represented by stored data sets in the searchable database, are copyrighted printed items" [Baxter, paragraph [0138]].

It would have been obvious to one of ordinary skill in the art at the time of invention to combine Baxter with Thomson (as modified by Google1) because both inventions are directed towards searching for documents.

Baxter's invention would have been expected to successfully work well with Thomson (as modified by Google1)'s invention because both inventions use databases. Thomson (as modified by Google1) discloses an information management systems comprising searching for documents relevant to a query, however Thomson (as modified by Google1) does not expressly disclose that these documents are copyrighted or that a permission protocol is used for the publisher to permit the search engine to display more text from the publication items. Baxter discloses a method an

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apparatus for safeguarding files comprising copyrighted documents/publications and a permission protocol.

It would have been obvious to one of ordinary skill in the art at the time of invention to take the copyrighted material from Baxter and install it into the invention of Thomson (as modified by Google1), thereby offering the obvious advantage of including more searchable material in the index of Thomson (as modified by Google1) to possibly retrieve more relevant results to a query.

24. **Claim 3** can be mapped to Thomson (as modified by Google1 and Baxter) as follows: "The method of claim 2, further including executing a permission protocol in which the publisher provides authorization that permits the search engine to display more text from said at least one of the relevant publication items" [Baxter, paragraphs [0037], [0041], [0141] and [0145] with Thomson, col. 8, lines 4-10 with Thomson, col. 8, lines 47-57 with Thomson, col. 3, lines 50-65].

25. **Claims 23 and 24** encompass substantially the same scope of the invention as that of Claims 2 and 3, respectfully, in addition to an arrangement and some elements for performing the method steps of Claims 2 and 3, respectfully. Therefore, Claims 23 and 24 are rejected for the same reasons as stated above with respect to Claims 2 and 3, respectfully.

26. For **Claim 48**, Thomson (as modified by Google1) teaches: "The machine-implemented method of claim 47."

Thomson (as modified by Google1) discloses the above limitation but does not expressly teach:

- “wherein the electronic path includes a path for accessing data made available according to a permission protocol.”

With respect to Claim 48, an analogous art, Baxter, teaches:

- “wherein the electronic path includes a path for accessing data made available according to a permission protocol” [Baxter, paragraphs [0037], [0041], [0141] and [0145] with Thomson, col. 8, lines 4-10 with Thomson, col. 8, lines 47-57 with Thomson, col. 3, lines 50-65].

It would have been obvious to one of ordinary skill in the art at the time of invention to combine Baxter with Thomson (as modified by Google1) because both inventions are directed towards searching for documents.

Baxter's invention would have been expected to successfully work well with Thomson (as modified by Google1)'s invention because both inventions use databases. Thomson (as modified by Google1) discloses an information management systems comprising searching for documents relevant to a query, however Thomson (as modified by Google1) does not expressly disclose that the path is made available according to a permissions protocol. Baxter discloses a method an apparatus for safeguarding files comprising a permission protocol.

It would have been obvious to one of ordinary skill in the art at the time of invention to take the permission protocol from Baxter and install it into the invention of Thomson (as modified by Google1), thereby offering the obvious advantage of safeguarding files from non-authorized users so that non-authorized users are not given a path to access the document.

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27. For **Claim 49**, Thomson (as modified by Google1) teaches: "The machine-implemented method of claim 47."

Thomson (as modified by Google1) discloses the above limitation but does not expressly teach:

- "wherein the electronic path provides access to further information made available by a publisher of the further information" [Baxter, paragraphs [0037], [0041], [0141] and [0145] with Thomson, col. 8, lines 4-10 with Thomson, col. 8, lines 47-57 with Thomson, col. 3, lines 50-65].

With respect to Claim 49, an analogous art, Baxter, teaches:

- "wherein the electronic path provides access to further information made available by a publisher of the further information" [Baxter, paragraphs [0037], [0041], [0141] and [0145] with Thomson, col. 8, lines 4-10 with Thomson, col. 8, lines 47-57 with Thomson, col. 3, lines 50-65].

It would have been obvious to one of ordinary skill in the art at the time of invention to combine Baxter with Thomson (as modified by Google1) because both inventions are directed towards searching for documents.

Baxter's invention would have been expected to successfully work well with Thomson (as modified by Google1)'s invention because both inventions use databases. Thomson (as modified by Google1) discloses an information management systems comprising searching for documents relevant to a query, however Thomson (as modified by Google1) does not expressly disclose that the path provides access to further information made available by a publisher of the further information. Baxter

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discloses a method an apparatus for safeguarding files comprising copyrighted documents/publications and a permission protocol.

It would have been obvious to one of ordinary skill in the art at the time of invention to take the permission protocol from Baxter and install it into the invention of Thomson (as modified by Google1), thereby offering the obvious advantage of safeguarding files from non-authorized users so that authorized users are given a path to access further information.

28. Claims 4-9 and 25-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,634,051 (Thomson) in view of "How to Interpret your Search Results" (Google1), further in view of U.S. Patent No. 6,502,076 (Smith).

29. For **Claim 4**, Thomson (as modified by Google1) teaches: "The method of claim 1, wherein storing data sets representing printed items includes."

Thomson (as modified by Google1) discloses the above limitation but does not expressly teach: "storing data sets representing advertisements printed with the printed items."

With respect to Claim 4, an analogous art, Smith, teaches: "storing data sets representing advertisements printed with the printed items" [Smith, cols. 2-3, lines 59-5].

It would have been obvious to one of ordinary skill in the art at the time of invention to combine Smith with Thomson (as modified by Google1) because both inventions are directed towards displaying documents on the web.

Smith's invention would have been expected to successfully work well with Thomson (as modified by Google1)'s invention because both inventions use computers to display documents. Thomson (as modified by Google1) discloses a an information management systems comprising searching for documents relevant to a query, however Thomson (as modified by Google1) does not expressly disclose that advertisements from the printed items are also stored in data sets. Smith discloses a system and methods for determining and displaying product promotions comprising a database of ads with their associated information.

It would have been obvious to one of ordinary skill in the art at the time of invention to take the database of ads with their associated information from Smith and install it into the invention of Thomson (as modified by Google1), thereby offering the obvious advantage of storing/maintaining the ads independently which allows for advertisements to be modified independently, and the reuse/repeating of the same advertisement multiple times.

Thomson, Google1, and Smith all fail to teach that advertisements are in printed items. Official notice is taken that it is old and well known in the document art that to get the advantage of complete document integrity it is necessary to include advertisements in the storing of printed items that contain advertisements. It would have been obvious to one of ordinary skill in the art at the time of invention to include advertisements to get this advantage.

30. **Claim 5** can be mapped to Thomson (as modified by Google1 and Smith) as follows: "The method of claim 4, wherein storing data sets representing the

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advertisements includes storing information for linking to information about a product represented in one of the advertisements" [Smith, cols. 2-3, lines 59-5].

31. **Claim 6** can be mapped to Thomson (as modified by Google1 and Smith) as follows: "The method of claim 4, wherein storing data sets representing the advertisements includes storing information for displaying information about a product represented in one of the advertisements" [Smith, cols. 2-3, lines 59-5].

32. **Claim 7** can be mapped to Thomson (as modified by Google1 and Smith) as follows: "The method of claim 4, wherein storing data sets representing the advertisements includes storing information directing the search engine to update advertisement information for one of the relevant printed items" [Smith, cols. 11-12, lines 61-14].

33. **Claim 8** can be mapped to Thomson (as modified by Google1 and Smith) as follows: "The method of claim 4, wherein storing data sets representing printed items includes storing data sets representing advertisements printed with the printed items; [Smith, cols. 2-3, lines 59-5] and wherein returning at least one characterization of at least one of the relevant printed items includes returning information from a data set representing an advertisement for said at least one of the relevant printed items" [Smith, cols. 2-3, lines 59-5 with Google1, page 1].

34. **Claim 9** can be mapped to Thomson (as modified by Google1 and Smith) as follows: "The method of claim 8, wherein returning information from a data set representing an advertisement includes returning information representing at least one of: information for linking to information about a product represented in one of the



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advertisements, information for displaying information about a product represented in one of the advertisements, information directing the search engine to update advertisement information for one of the relevant printed items" [Smith, cols. 2-3, lines 59-5].

35. **Claims 25-30** encompass substantially the same scope of the invention as that of Claims 4-9, respectfully, in addition to an arrangement and some elements for performing the method steps of Claims 4-9, respectfully. Therefore, Claims 25-30 are rejected for the same reasons as stated above with respect to Claims 4-9, respectfully.

36. Claims 10, 31, and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,634,051 (Thomson) in view of "How to Interpret your Search Results" (Google1), further in view of U.S. Patent No. 5,963,966 (Mitchell et al.).

37. For **Claim 10**, Thomson (as modified by Google1) teaches: "The method of claim 1."

Thomson (as modified by Google1) discloses the above limitation but does not expressly teach:

- "further including electronically scanning the printed items and generating scanned printed items, and wherein the stored data sets representing printed items in the searchable database includes data sets representing the scanned printed items."

With respect to Claim 10, an analogous art, Mitchell, teaches:

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- “further including electronically scanning the printed items and generating scanned printed items, and wherein the stored data sets representing printed items in the searchable database includes data sets representing the scanned printed items” [Mitchell, col. 6, lines 33-44 with Thomson, col. 10, lines 1-5].

It would have been obvious to one of ordinary skill in the art at the time of invention to combine Mitchell with Thomson (as modified by Google1) because both inventions are directed towards converting documents to electronic form.

Mitchell's invention would have been expected to successfully work well with Thomson (as modified by Google1)'s invention because both inventions convert documents to an electronic format. Thomson (as modified by Google1) discloses an information management systems comprising searching for documents relevant to a query, however Thomson (as modified by Google1) does not expressly disclose that the documents for searching are converted to electronic form by scanning. Mitchell discloses automated capture of technical documents for electronic review and distribution comprising scanning and OCRing of documents.

It would have been obvious to one of ordinary skill in the art at the time of invention to take the scanning and OCRing of documents from Mitchell and install it into the electron conversion system of Thomson (as modified by Google1), thereby offering the obvious advantage of having a automated way of inputting documents into the database.

38. **Claim 31** encompasses substantially the same scope of the invention as that of Claim 10 in addition to an arrangement and some elements for performing the method

steps of Claim 10. Therefore, Claim 31 is rejected for the same reasons as stated above with respect to Claim 10.

39. For **Claim 42**, Thomson (as modified by Google1) teaches: "The arrangement of claim 22, further including."

Thomson (as modified by Google1) discloses the above limitation but does not expressly teach:

- "an item-input arrangement including both a document scanner and a download path arranged to download another electronic version of at least one of the printed items, the item-input arrangement adapted to generate electronic versions of the printed items."

With respect to Claim 42, an analogous art, Mitchell, teaches:

- "an item-input arrangement including both a document scanner and a download path arranged to download another electronic version of at least one of the printed items, the item-input arrangement adapted to generate electronic versions of the printed items" [Mitchell, col. 7, lines 6-14]."

It would have been obvious to one of ordinary skill in the art at the time of invention to combine Mitchell with Thomson (as modified by Google1) because both inventions are directed towards converting documents to electronic form.

Mitchell's invention would have been expected to successfully work well with Thomson (as modified by Google1)'s invention because both inventions convert documents to an electronic format. Thomson (as modified by Google1) discloses an information management systems comprising searching for documents relevant to a

query, however Thomson (as modified by Google1) does not expressly disclose that the documents for searching are converted to electronic form by scanning. Mitchell discloses automated capture of technical documents for electronic review and distribution comprising scanning and OCRing of documents.

It would have been obvious to one of ordinary skill in the art at the time of invention to take the scanner and download path (OCR) from Mitchell and install it into the invention of Thomson (as modified by Google1), thereby offering the obvious advantage of having an automated process to convert documents speeding up conversion.

40. Claims 11, 12, 32, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,634,051 (Thomson) in view of "How to Interpret your Search Results" (Google1) in view of U.S. Patent No. 5,963,966 (Mitchell et al.), further in view of U.S. Patent Application Publication No. 2003/0229637 (Baxter et al.).

41. For **Claim 11**, Thomson (as modified by Google1 and Mitchell) teaches: "The method of claim 10."

Thomson (as modified by Google1 and Mitchell) discloses the above limitation but does not expressly teach:

- "wherein the scanned printed items are copyrighted printed items, and further including executing a permission protocol in which the publisher provides authorization over the Internet that permits the search engine to display more text from said at least one of the relevant publication items, the authorization being in

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response to the search engine providing the electronic path for accessing further information for said at least one of the relevant publication items."

With respect to Claim 11, an analogous art, Baxter, teaches:

- "wherein the scanned printed items are copyrighted printed items, [Baxter, paragraph [0138]] and further including executing a permission protocol in which the publisher provides authorization over the Internet that permits the search engine to display more text from said at least one of the relevant publication items, [Baxter, paragraphs [0037], [0041], [0141] and [0145] with Thomson, col. 8, lines 4-10 with Thomson, col. 8, lines 47-57 with Thomson, col. 3, lines 50-65] the authorization being in response to the search engine providing the electronic path for accessing further information for said at least one of the relevant publication items [Baxter, paragraph [0144]].

It would have been obvious to one of ordinary skill in the art at the time of invention to combine Baxter with Thomson (as modified by Google1 and Mitchell) because both inventions are directed towards searching for documents.

Baxter's invention would have been expected to successfully work well with Thomson (as modified by Google1 and Mitchell)'s invention because both inventions use databases. Thomson (as modified by Google1 and Mitchell) discloses an information management systems comprising searching for documents relevant to a query, however Thomson (as modified by Google1 and Mitchell) does not expressly disclose that these documents are copyrighted or that a permission protocol is used for the publisher to permit the search engine to display more text from the publication

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items. Baxter discloses a method and apparatus for safeguarding files comprising copyrighted documents/publications and a permission protocol.

It would have been obvious to one of ordinary skill in the art at the time of invention to take the copyrighted material from Baxter and install it into the invention of Thomson (as modified by Google1 and Mitchell), thereby offering the obvious advantage of including more searchable material in the index of Thomson (as modified by Google1 and Mitchell) to possibly retrieve more relevant results to a query.

42. For **Claim 12**, Thomson (as modified by Google1 and Mitchell) teaches: "The method of claim 10."

Thomson (as modified by Google1 and Mitchell) discloses the above limitation but does not expressly teach:

- "wherein the scanned printed items are copyrighted printed items, and further including executing a permission protocol in which the publisher provides authorization over the Internet that permits the search engine to display more text from said at least one of the relevant publication items, the authorization being in response to a representative of the publisher submitting the search query and, in response the search engine providing the electronic path for accessing further information for said at least one of the relevant publication items."

With respect to Claim 12, an analogous art, Baxter, teaches:

- "wherein the scanned printed items are copyrighted printed items, [Baxter, paragraph [0138]] and further including executing a permission protocol in which the publisher provides authorization over the Internet that permits the search

engine to display more text from said at least one of the relevant publication items, [Baxter, paragraphs [0037], [0041], [0141] and [0145] with Thomson, col. 8, lines 4-10 with Thomson, col. 8, lines 47-57 with Thomson, col. 3, lines 50-65] the authorization being in response to a representative of the publisher submitting the search query and, in response the search engine providing the electronic path for accessing further information for said at least one of the relevant publication items" [Baxter, paragraphs [0080], [0143] and [0144]].

It would have been obvious to one of ordinary skill in the art at the time of invention to combine Baxter with Thomson (as modified by Google1 and Mitchell) because both inventions are directed towards searching for documents.

Baxter's invention would have been expected to successfully work well with Thomson (as modified by Google1 and Mitchell)'s invention because both inventions use databases. Thomson (as modified by Google1 and Mitchell) discloses an information management systems comprising searching for documents relevant to a query, however Thomson (as modified by Google1 and Mitchell) does not expressly disclose that these documents are copyrighted or that a permission protocol is used for the publisher to permit the search engine to display more text from the publication items. Baxter discloses a method an apparatus for safeguarding files comprising copyrighted documents/publications and a permission protocol.

It would have been obvious to one of ordinary skill in the art at the time of invention to take the copyrighted material from Baxter and install it into the invention of Thomson (as modified by Google1 and Mitchell), thereby offering the obvious

advantage of including more searchable material in the index of Thomson (as modified by Google1 and Mitchell) to possibly retrieve more relevant results to a query.

43. **Claims 32 and 33** encompass substantially the same scope of the invention as that of Claims 11 and 12, respectfully, in addition to an arrangement and some elements for performing the method steps of Claims 11 and 12, respectfully. Therefore, Claims 32 and 33 are rejected for the same reasons as stated above with respect to Claims 11 and 12, respectfully.

44. Claims 18 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,634,051 (Thomson) in view of "How to Interpret your Search Results" (Google1), further in view of U.S. Patent No. 5,832,212 (Cragun et al.).

45. For **Claim 18**, Thomson (as modified by Google1) teaches: "The method of claim 1."

Thomson (as modified by Google1) discloses the above limitation but does not expressly teach: "further including blocking portions of the relevant publication items that are not authorized for distribution."

With respect to Claim 18, an analogous art, Cragun, teaches: "further including blocking portions of the relevant publication items that are not authorized for distribution" [Cragun, cols, 6-7, lines 54-17].

It would have been obvious to one of ordinary skill in the art at the time of invention to combine Cragun with Thomson (as modified by Google1) because both inventions are directed towards displaying content on the internet.



Cragun's invention would have been expected to successfully work well with Thomson (as modified by Google1)'s invention because both inventions use web browsers. Thomson (as modified by Google1) discloses an information management systems comprising searching for documents relevant to a query, however Thomson (as modified by Google1) does not expressly disclose blocking out content not authorized to be viewed. Cragun discloses censoring browser method and apparatus for internet viewing comprising blocking out unauthorized content.

It would have been obvious to one of ordinary skill in the art at the time of invention to take the blocking out unauthorized content from Cragun and install it into the invention of Thomson (as modified by Google1), thereby offering the obvious advantage of gaining document security for portions of documents not to be viewed.

46. **Claim 39** encompasses substantially the same scope of the invention as that of Claim 18 in addition to an arrangement and some elements for performing the method steps of Claim 18. Therefore, Claim 39 is rejected for the same reasons as stated above with respect to Claim 18.

47. Claims 19 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,634,051 (Thomson) in view of "How to Interpret your Search Results" (Google1), further in view of "Google Search Technology" (Google2).

48. For **Claim 19**, Thomson (as modified by Google1) teaches: "The method of claim 1."

Thomson (as modified by Google1) discloses the above limitation but does not expressly teach: "wherein returning includes embedding advertisements with said at least one characterization of at least one of the relevant publication items."

With respect to Claim 19, an analogous art, Google2, teaches:

- "wherein returning includes embedding advertisements with said at least one characterization of at least one of the relevant publication items" [Google2, Page 1, under Integrity].

It would have been obvious to one of ordinary skill in the art at the time of invention to combine Google2 with Thomson (as modified by Google1) because both inventions are directed towards searching for documents.

Google2's invention would have been expected to successfully work well with Thomson (as modified by Google1)'s invention because both inventions return search results. Thomson (as modified by Google1) discloses an information management systems comprising searching for documents relevant to a query, however Thomson (as modified by Google1) does not expressly disclose embedding advertisements with characterization(s). Google2 discloses search results comprising advertisements/ads.

It would have been obvious to one of ordinary skill in the art at the time of invention to take the ads from Google2 and install it into the invention of Thomson (as modified by Google1), thereby offering the obvious advantage of including more relevant results in the form of ads.

49. **Claim 40** encompasses substantially the same scope of the invention as that of Claim 19 in addition to an arrangement and some elements for performing the method

steps of Claim 19. Therefore, Claim 40 is rejected for the same reasons as stated above with respect to Claim 19.

50. Claims 20 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,634,051 (Thomson) in view of "How to Interpret your Search Results" (Google1), further in view of U.S. Patent No. 6,920,448 (Kincaid et al.).

51. For **Claim 20**, Thomson (as modified by Google1) teaches: "The method of claim 1."

Thomson (as modified by Google1) discloses the above limitation but does not expressly teach: "wherein using the search engine includes returning ranked characterizations of the relevant web pages and of the relevant publication items, [Kincaid, col. 8, lines 63-67] and wherein the ranked characterizations include hyperlinks to respective electronic images of the relevant printed items."

With respect to Claim 20, an analogous art, Kincaid, teaches: "wherein using the search engine includes returning ranked characterizations of the relevant web pages and of the relevant publication items" [Kincaid, col. 8, lines 63-67].

With respect to Claim 20, an analogous art, Mitchell, teaches: "and wherein the ranked characterizations include hyperlinks to respective electronic images of the relevant printed items" [Mitchell, col. 7, lines 42-50 with Google1, page 1].

It would have been obvious to one of ordinary skill in the art at the time of invention to combine Kincaid and Mitchell with Thomson (as modified by Google1) because both inventions are directed towards accessing documents.

Kincaid's and Mitchell's invention would have been expected to successfully work well with Thomson (as modified by Google1)'s invention because both inventions use databases. Thomson (as modified by Google1) discloses an information management systems comprising searching for documents relevant to a query, however Thomson (as modified by Google1) does not expressly disclose ranking the results of the relevant documents or providing a link to the image of the document. Kincaid discloses domain specific knowledge-based metasearch system and methods of using it comprising ranked results of a document search. Mitchell discloses automated capture of technical documents for electronic review and distribution comprising accessing the images of the scanned documents.

It would have been obvious to one of ordinary skill in the art at the time of invention to take the ranked results of a document search from Kincaid and the images of the scanned documents from Mitchell and install it into the invention of Thomson (as modified by Google1), thereby offering the obvious advantage of showing most relevant results first and including a view to the original document.

52. **Claim 41** encompasses substantially the same scope of the invention as that of Claim 20 in addition to an arrangement and some elements for performing the method steps of Claim 20. Therefore, Claim 41 is rejected for the same reasons as stated above with respect to Claim 20.

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53. Claims 43 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,634,051 (Thomson) in view of U.S. Patent Application Publication No. 2003/0229637 (Baxter et al.),

54. For **Claim 43**, Thomson teaches: "An arrangement for maintaining an electronic database [Thomson, col. 5, lines 15-20] that is searchable via a search engine [Thomson, col. 4, lines 36-41] in response to Internet-based search queries, [Thomson, col. 3, lines 47-50 with Thomson, col. 4, lines 9-13] the arrangement comprising:

- means for storing in the searchable database data sets representing printed items from publications respectively printed by a plurality of respective publishers, [Thomson, col. 10, lines 1-16 with Thomson, col. 8, lines 4-21] each data set including text from at least one of the printed items; [Thomson, col. 8, lines 4-21] and"

Thomson discloses the above limitations but does not expressly teach:

- "with each stored data set representing printed items from publications, means for recording whether the respective publisher has authorized display of the printed item."

With respect to Claim 43, an analogous art, Baxter, teaches:

- "with each stored data set representing printed items from publications, means for recording whether the respective publisher has authorized display of the printed item" [Baxter, paragraphs [0037], [0041], [0141] and [0145]].

It would have been obvious to one of ordinary skill in the art at the time of invention to combine Baxter with Thomson because both inventions are directed towards searching for documents.

Baxter's invention would have been expected to successfully work well with Thomson's invention because both inventions use databases. Thomson discloses an information management systems comprising searching for documents relevant to a query, however Thomson does not expressly disclose copyrighted material or that a publisher can authorize the display of items. Baxter discloses a method an apparatus for safeguarding files comprising copyrighted documents/publications and a way to determine if they should be displayed.

It would have been obvious to one of ordinary skill in the art at the time of invention to take the copyrighted material with the determination if they should be displayed from Baxter and install it into the invention of Thomson, thereby offering the obvious advantage of including more searchable material in the index of Thomson (as modified by Google1) to possibly retrieve more relevant results to a query, and control the access to documents to safeguard them from non-authorized people.

55. **Claim 45** encompasses substantially the same scope of the invention as that of Claim 43 in addition to an arrangement and some elements for performing the method steps of Claim 43. Therefore, Claim 45 is rejected for the same reasons as stated above with respect to Claim 43.

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56. Claims 44 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,634,051 (Thomson) in view of U.S. Patent Application Publication No. 2003/0229637 (Baxter et al.), further in view of "How to Interpret your Search Results" (Google1).

57. For **Claim 44**, Thomson (as modified by Baxter) teaches: "The arrangement of claim 45, further comprising: means, responsive to a search query and including the search engine, for

- and searching the data sets in the electronic database for data sets that are relevant to the search query, thereby identifying and relevant data sets corresponding to relevant publication items, [Thomson, col. 8, lines 16-21] and
- and at least one characterization of at least one of the relevant publication items copyrighted [Baxter, paragraph [0138]].

Thomson (as modified by Baxter) discloses the above limitations but does not expressly teach:

- "searching for web pages that are relevant for the search query
- relevant Internet web pages
- returning at least one characterization of at least one of the relevant web pages
- and, for said at least one of the relevant publication items for which the respective publisher has authorized display, providing an electronic path for accessing a version thereof."

With respect to Claim 44, an analogous art, Google1, teaches:

- “searching for web pages that are relevant for the search query [Google1, page 1]
- relevant Internet web pages [Google1, page 1]
- returning at least one characterization of at least one of the relevant web pages [Google1, page 1]
- and, for said at least one of the relevant publication items for which the respective publisher has authorized display, providing an electronic path for accessing a version thereof” [Google1, page 1 with Thomson, col. 8, lines 4-10].

It would have been obvious to one of ordinary skill in the art at the time of invention to combine Google1 with Thomson (as modified by Baxter) because both inventions are directed towards searching documents.

Google1's invention would have been expected to successfully work well with Thomson (as modified by Baxter)'s invention because both inventions use the internet for searching. Thomson (as modified by Baxter) discloses an information management systems comprising searching for documents relevant to a query, however Thomson (as modified by Baxter) does not expressly disclose web pages as search results and characterizations thereof or electronic paths for access. Google1 discloses search results from Google comprising web pages as search results and characterizations thereof.

It would have been obvious to one of ordinary skill in the art at the time of invention to take the web pages as search results, characterizations thereof, and electronic paths for access from Google1 and install it into the invention of Thomson (as



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modified by Baxter), thereby offering the obvious advantage of finding web pages associated with the documents found, accessing them and the user quickly determining the relevance of the returned result(s).

58. **Claim 46** encompasses substantially the same scope of the invention as that of Claim 44 in addition to an arrangement and some elements for performing the method steps of Claim 44. Therefore, Claim 46 is rejected for the same reasons as stated above with respect to Claim 44.

**Conclusion**

59. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant is advised that, although not used in the rejections above, prior art cited on the PTO-892 form and not relied upon is considered materially relevant to the applicant's claimed invention and/or portions of the claimed invention.

60. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brent S. Stace whose telephone number is 571-272-8372 and fax number is 571-273-8372. The examiner can normally be reached on M-F 9am-5:30pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Gaffin can be reached on 571-272-4146. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Brent Stace

  
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